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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,493	10/01/2003	Hideo Ikeno	00862.023254.	4231
5514 7590 04/02/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER HUNTSINGER, PETER K				
ART UNIT 2625		PAPER NUMBER		
MAIL DATE 04/02/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/674,493

**Applicant(s)**

IKENO, HIDEO

**Examiner**

Peter K. Huntsinger

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19, 22, 23, 26 and 28-33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 19, 22, 23, 26 and 28-33 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/2/09 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 3/2/09 have been fully considered but they are not persuasive.

The applicant argues on pages 7 and 8 of the response in essence that: The cited prior art fails to disclose setting display names of a resource or information indicating that a display name is not displayed for each of the resources retained by a retention means, wherein the display names or the information indicating that a display name is not displayed is set for each of the resources and for each print language used in the image processing apparatus.

- a. Ukai '506 discloses setting means for setting display names of a resource for each of the resources retained by the retention means (col. 18-19, lines 66-67, 1-4, user may rename file by using a dialog box). The applicant's background section discloses wherein the display names set for each of the resources are different for different print languages used in

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the image processing apparatus (page 4, lines 10-15, the resource is displayed under a separate name for each print language in the image forming apparatus). The claim language that the applicant argues the cited prior art fails to disclose (i.e. setting means for setting information indicating that a display name is not displayed) is stated in the alternative form. Therefore, the cited prior art meets the claim limitation by disclosing one of the two alternatives.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, a process claim must (1) be tied to a particular machine or apparatus, or (2) transform underlying subject matter to a different state or thing. Additionally, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. Currently claim 28 does neither of these requirements and is therefore non-statutory.

***Claim Rejections - 35 USC § 103***

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19, 23, 26, 28 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's admitted prior art, and further in view of Ukai '506.

Referring to **claims 19, 26 and 31**, the applicant's background section discloses a data processing apparatus, which communicates with an image processing apparatus that processes image data by using resources retained in memory, comprising:

retention means for retaining resources which are utilized in image processing (page 1, lines 11-24, resource retention area provided within image forming apparatus retains resource data such as fonts, color profiles and dither patterns used in forming an image); and

wherein the display names or the information indicating that a display name is not displayed is set for each of the resources and for each print language used in the image processing apparatus by said setting means (page 4, lines 10-15, the resource is displayed under a separate name for each print language in the image forming apparatus).

The applicant's background section does not disclose expressly setting means for setting display names of a resource.

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Ukai '506 discloses setting means for setting display names of a resource or information indicating that a display name is not displayed for each of the resources retained by the retention means (col. 18-19, lines 66-67, 1-4, user may rename file by using a dialog box).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to set a display name for a file. The motivation for doing so would have been to allow a user to customize the file name of a file to their liking. Therefore, it would have been obvious to combine Ukai '506 with the applicant's admitted prior art to obtain the invention as specified in claim 19.

Referring to **claims 23, 30, and 33**, the applicant's background section discloses wherein the resources include a font resource used in printing, and/or a form resource for forming an image by being superimposed on print data at the time of printing, and/or a color-profile resource that expresses color space of an input/output device, and/or a look-up-table resource, which is a conversion table for color correction in color processing, and/or a dither-pattern resource, which is pattern data for deciding expression of color in color processing (page 1, lines 11-15, resource data such as fonts, color profiles and dither patterns used in forming an image is retained within the image forming apparatus).

Referring to **claim 28**, the applicant's background section discloses a method for communication of a data processing apparatus with an image processing apparatus that processes image data by using resources retained in memory, comprising:

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retaining resources which are utilized in image processing (page 1, lines 11-24, resource retention area provided within image forming apparatus retains resource data such as fonts, color profiles and dither patterns used in forming an image);

wherein the display names or the information indicating that a display name is not displayed is set for each of the resources and for each are print language used in the image processing apparatus in said setting step (page 4, lines 10-15, the resource is displayed under a separate name for each print language in the image forming apparatus); and

displaying the resources using the set display names means (page 4, lines 10-15, the resource is displayed under a separate name for each print language in the image forming apparatus)

The applicant's background section does not disclose expressly setting means for setting display names of a resource.

Ukai '506 discloses setting display names or information indicating that a display name is not displayed for each of the resources retained in the retaining step (col. 18-19, lines 66-67, 1-4, user may rename file by using a dialog box).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to set a display name for a file. The motivation for doing so would have been to allow a user to customize the file name of a file to their liking. Therefore, it would have been obvious to combine Ukai '506 with the applicant's admitted prior art to obtain the invention as specified in claim 28.

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7. Claims 22, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's admitted prior art and Ukai '506 as applied to claims 20, 28 and 31 above, and further in view of Forstall '869.

Referring to **claims 22, 29, and 32**, Ukai '506 discloses setting means for setting display names for a resource but does not disclose expressly wherein the information indicates that the resource is not to be displayed.

Forstall '869 discloses information indicates that when a setting means indicate a predetermined value, the data processing apparatus is controlled so that one of the resources is not displayed (col. 5, lines 33-57, hide extension bit associated with a file name).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to not display a resource. The motivation for doing so would have been to give the user a certain degree of control over the visibility of the user interface. Therefore, it would have been obvious to combine Forstall '869 with the applicant's admitted prior art and Ukai '506 to obtain the invention as specified in claim 22.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax



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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K. Huntsinger/  
Examiner, Art Unit 2625

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625